



09-08-04

AF/ 2876 # / ign

ref: FIR-4A-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE

BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Application of: P. A. FIRESTONE :
Art Unit: 2876
Serial No. : 09/635,624 :
Filed : August 10, 2000 : Examiner: J. A.
Franklin
Title : SYSTEM AND METHOD FOR :
COLLECTING VEHICLE FEES Dated : 9/7/04
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MAIL STOP APPEAL BRIEF - PATENTS

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- (1) Appeal brief in triplicate; and
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PTO/SB/17 (10-03)

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 165

Complete if Known

Application Number	09/635,624
Filing Date	August 10, 2000
First Named Inventor	P. A. Firestone
Examiner Name	J. A. Franklin
Art Unit	2876
Attorney Docket No.	FIR-4A-US

METHOD OF PAYMENT (check all that apply)☐ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:

Deposit Account Number 02-2275

Deposit Account Name Muserlian, Lucas and Mercanti

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	X	
Independent Claims	-3** =	X	
Multiple Dependent			

Large Entity		Small Entity		Fee Description	
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	165
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 165

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)	Donald C. Lucas	Registration No. (Attorney/Agent)	31,275	Telephone	212-661-8000
Signature		Date	September 7, 2004		

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Our ref: FIR-4A-US

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: :
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APPEAL BRIEF

09/09/2004 JBALINAN 00000042 09635624

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165.00 OP

(1) Real Party in Interest

The real party in interest is Appellant, Mr. Paul A. Firestone. This Application has not been assigned and is currently not under an obligation of assignment.

(2) Related Appeals and Interferences

There are no other related Appeals or Interferences.

(3) Status of Claims

Claims 11, 13, 15, 16, 18, 20, 22, 23, 25 and 26 are pending in this Application. Claims 1-10, 12, 14, 17, 19, 21 and 24 have been cancelled.

The rejection of pending claims 11, 13, 15, 16, 18, 20, 22, 23, 25 and 26 has been appealed. The appealed claims have been at least twice rejected.

(4) Status of Amendments

No amendment has been filed subsequent to the last Office Action dated June 16, 2004.

(5) Summary of Invention

The present invention is directed to a method and system for collecting vehicular road use fees. The vehicular road use fees are collected by reading a vehicle identifier attached to a vehicle (page 4, lines 1-4). The vehicle identifier is read using a stationary reader when the vehicle is moving, and is read using a mobile reader when the vehicle is stationary (page 3, lines 19-22). The mobile reader allows for hand-held reading by traffic managers (page 4, lines 7-9) to immediately and easily record traffic accidents and the like (page 4, lines 13-15).

The information read by the stationary and mobile readers is communicated to a central agency where a road use fee is charged (page 3, lines 19-20 and page 4, lines 5-6). The central agency is the same agency that issues the vehicle's registration (page 4, line 12 and page 5, line 16), and thus has access to a large quantity of information associated with the vehicle. The central agency communicates a portion of this information to the stationary and mobile readers in order to notify the operator of the reader whether, for example, an action needs to be taken because the vehicle is unregistered,

uninspected, uninsured or requires the charging of additional fees (page 6, lines 5-8).

(6) Issues

A) Do the cited references taken as a whole teach or suggest communicating the vehicle identifier to a central agency by reading the vehicle identifier using a mobile reader, and communicating vehicle information (e.g. registration information) based on the vehicle identifier from the central agency back to the mobile reader (e.g. to notify the operator whether an action needs to be taken)?

B) Do the cited references taken as a whole teach or suggest issuing a mandatory vehicle identifier by the governmental agency that issues the vehicle's registration and compiles information concerning the vehicle?

(7) Grouping of Claims

All claims stand or fall together.

(8) Argument

A. Summary of the last Office Action dated June 16, 2004

Each of the appealed claims have been rejected under 35 U.S.C. 103(a) as being unpatentable over Urbish (US 5,734,343) in view of Slavin (US 5,819,234) and Leitner (US 5,587,575).

Urbish has been cited to teach a way to eliminate the need for a tollbooth by using a detector to read information from a label attached to the vehicle as the vehicle passes under a fixed light source (page 2, lines 12-13 and page 3, lines 4-5 of the Office Action). Figure 1 of Urbish illustrates labels 15 affixed to vehicle 10. A beam of infrared light sent from source 20 reflects from labels 15 (light-readable indicia) and is detected by light detector 25 to determine the identity of vehicle 10 (col. 2, lines 27-39 of Urbish). In sum, Urbish teaches a fixed reader for identifying and collecting a toll from a moving vehicle.

Slavin has been cited to teach the establishment of an account at a central agency to accumulate toll fees generated from a readable transponder tag (page 3, lines 11-12 of the Office Action). The toll collection system of Slavin uses a pre-authorized transponder kit having a

predetermined toll credit that is purchased from a retail vender (col. 1, lines 4-8). The transponder kits are encoded at a central billing computer before they are distributed to the retail vendor (col. 3, lines 11-15). During use, a toll plaza, a stationary reader, reads the transponder and communicates information to the central billing computer (col. 5, lines 53-59).

Leitner has been cited to teach a mobile reader that reads a stationary vehicle (page 5, lines 2-4 of the Office Action). The mobile reader of Leitner is used to identify a vehicle by decrypting a code attached to the vehicle (col. 1, lines 13-24). The decrypted data is compared with the features of the vehicle to determine whether the vehicle has been stolen (col. 5, lines 43-54). In addition, Leitner further teaches that the code contains a PIN that can be matched with the PIN given by the driver to determine whether the driver is authorized to operate the vehicle (col. 1, lines 29-37).

The Examiner has taken the position that it would be obvious to use the fixed scanner of Urbish to send information to the central account of Slavin, and to further modify this combination by including the mobile reader of Leitner (page 4, lines 5-8).

B. The cited references do not teach or suggest the parallel exchange of information between a mobile reader and a central agency

The vehicle identification system of Leitner is a stand-alone unit that identifies a vehicle without communicating with any external source. Leitner explains that authorized traffic officials or police are issued with a code reading means to stop traveling vehicles in order to scan the code on the vehicle (col. 4, lines 62-66). The operator of the unit performs an on-site decryption of the code to ascertain details of the vehicle (col. 4, line 66 to col. 5, line 5). An on-site comparison is then made between the decrypted details and the features of the vehicle, and/or PIN given by the driver, to determine whether the vehicle is stolen (col. 5, lines 6-17). Leitner specifically explains that his identification system operates "without the need to refer to a central database" (col. 5, lines 43-46).

In contrast to Leitner, independent claims 11 and 18 recite a parallel, two-way communication system between a mobile reader and a central agency, where the mobile reader communicates the vehicle identifier to the central agency and the central agency communicates information to the mobile reader. As discussed above, the present invention

is concerned with notifying the operator of the reader whether, for example, the vehicle is unregistered or requires the charging of additional fees. This information concerning the status of the vehicle can only be compiled in a central agency due to its sheer volume. The parallel, two-way communication that provides information from the central agency to the operator of the mobile reader is essential to the effectiveness of the present invention.

Leitner does not contemplate a two-way communication between a mobile reader and a central agency. The operator of the reader of Leitner is alone in the field with a reader that has no external communication ability. Leitner does not teach or suggest the object of the present invention, namely, to perform an active communication between the operator in the field and a central database to provide the operator with "real-time" status information concerning the vehicle. Leitner cannot accomplish this objective, since his device performs only an on-site interrogation of the driver of the vehicle and the vehicle itself.

This deficiency is not cured by Urbish or Slavin. The vehicle identification systems of Urbish and Slavin retrieve information using fixed readers at conventional toll plazas for the purpose of collecting tolls (col. 4,

lines 29-33 of Urbish and col. 3, lines 19-22 of Slavin). Urbish and Slavin do not contemplate a two-way system of reading a vehicle identifier using a mobile reader and sending information back to the reader to give the operator of the reader real-time information concerning the vehicle.

Thus, none of the cited references taken alone or in combination teach or suggest communicating the vehicle identifier to a central agency by reading the vehicle identifier using a mobile reader, and communicating vehicle information based on the vehicle identifier from the central agency to the mobile reader as recited in claims 11 and 18 (Issue A outlined above). It is therefore respectfully submitted that the present invention is patentable over the cited references.

C. The cited references do not teach or suggest issuing a mandatory vehicle identifier by the governmental agency that issues the vehicle's registration and compiles information concerning the vehicle

Claims 11 and 18 recite that the central agency is the same agency that issues the vehicle's registration, and thus has access to a large quantity of information associated with the vehicle. Information concerning the vehicle, such as registration information, is therefore

readily available and can be communicated to the operator of the reader instantaneously.

As discussed above, Urbish, Slavin and Leitner do not teach or suggest communicating information concerning the vehicle from the central agency to the reader. It logically follows that Urbish, Slavin and Leitner do not teach or suggest that the central agency is the same agency that issues the vehicle's registration in order to be able to communicate information concerning the vehicle to the reader (Issue B outlined above).

Appellant wishes to emphasize the importance of this aspect of the present invention. It is key to the efficient functioning of the present invention that the vehicle identifier is issued by a governmental agency that has access to information concerning the vehicle. This access facilitates the communication of detailed information concerning the vehicle from the central agency to the reader.

It is Appellant's position that this aspect of the invention provides additional grounds for patentability. Although, the communication of information from the central agency to the reader as discussed in paragraph B above is indeed one important aspect of the invention, it is the coordination between governmental agency's and the

communication of this information to the reader which is at the heart of Appellant's invention. It is respectfully submitted that the cited references do not teach or suggest the present invention.

D. Conclusion

Urbish, Slavin and Leitner, taken as a whole, do not teach or suggest the subject matter of independent claims 11 and 18. In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

MUSERLIAN, LUCAS AND MERCANTI, LLP

By: Donald C. Lucas
Donald C. Lucas, 31,275
Attorney for Appellant
475 Park Avenue South, 15th Floor
New York, New York
Tel. # 212-661-8000

Encl: Return receipt postcard

(9) Appendix

Claim 11

A method for collecting vehicular road use fees
comprising:

(a) issuing a mandatory unique vehicle identifier to
a vehicle by a governmental central agency that issues a
vehicular registration;

(b) inputting information concerning said vehicle to
said central agency;

(c) establishing an account at said central agency
for said vehicle to pay for road use fees;

(d) attaching said unique vehicle identifier to said
vehicle;

(e) reading said vehicle identifier with a mobile
reader when said vehicle is stationary and reading said
vehicle identifier with a stationary reader when said
vehicle is moving to retrieve said vehicle identifier from
said vehicle;

(f) communicating said vehicle identifier to said
central agency;

(g) charging said account with a road use fee; and

(h) communicating said information in said central
agency to said mobile and stationary reader.

Claim 13

The method for collecting vehicular road use fees of claim 11 wherein said vehicle identifier contains a VIN number of said vehicle.

Claim 15

The method for collecting vehicular road use fees of claim 11 wherein said road use fees comprise toll fees, fines, and parking fees.

Claim 16

The method for collecting vehicular road use fees of claim 11 wherein said mobile scanning device is hand held or transported via a manned scooter.

Claim 18

A system for collecting vehicular road use fees comprising:

(a) governmental central agency that issues both a mandatory unique vehicle identifier and a registration to each vehicle and stores information concerning each vehicle;

(b) a vehicle having said vehicle identifier attached to said vehicle;

(c) a stationary vehicle identifier reader for reading said vehicle identifier from a moving vehicle and communicating said vehicle identifier to said central agency;

(d) a mobile vehicle identifier reader for reading said vehicle identifier from a stationary vehicle and communicating said vehicle identifier to said central agency; and

(e) an account established by said central agency for each vehicle to charge road use fees to each vehicle when said stationary reader or mobile reader communicates said vehicle identifier to said central agency;

wherein said central agency communicates said information to said mobile and stationary reader.

Claim 20

The system for collecting vehicle road use fees of claim 18 wherein said vehicle identifier contains a VIN number of said vehicle.

Claim 22

The system for collecting vehicular road use fees of claim 18 wherein said road use fees comprise toll fees, fines, and parking fees.

Claim 23

The system for collecting vehicular road use fees of claim 18 wherein said mobile scanning device is hand held or transported via a manned scooter.

Claim 25

The method for collecting vehicular road use fees of claim 11 wherein said information comprises vehicle title, insurance, driver licenses, inspection, or emissions.

Claim 26

The system for collecting vehicular road use fees of claim 18 wherein said information comprises vehicle title, insurance, driver licenses, inspection, or emissions.